

**REMARKS**

In the Office Action mailed September 2, 2009 ("the Office Action"), the Examiner rejected claims 1-13, 15-29, and 31-41 under 35 U.S.C. § 101 as being directed to non-statutory subject matter; rejected claims 1-6, 8-13, 16-22, 24-29, and 32-41 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,605,081 of Helmly ("Helmly"); and rejected claims 7, 15, 23, and 31 under 35 U.S.C. § 103(a) as being unpatentable over Helmly in view of U.S. Patent No. 7,136,787 of Schlessinger et al. ("Schlessinger").

Claims 1-13, 15, 16, and 41 have been cancelled; claims 17, 18, 20-29, 31-33, and 37-40 have been amended; and new claims 42-50 have been added. Claims 17-29, 31-40, and 42-50 are pending in the application. No new matter has been added by this Reply.

**§ 101 Rejection**

In the rejection of claims 1-13, 15-29, and 31-41 under § 101, the Examiner alleged that claims 1-13, 15-29, and 31-41 are directed to non-statutory subject matter. In particular, the Examiner alleged that there is no transformation in claims 1-13, 15-29, and 31-41, and that any use of technology is insignificant and, as such, is deemed non-statutory.

Claims 1-13, 15, 16, and 41 have been cancelled. For this reason, the § 101 rejection of these claims has been rendered moot.

Applicant respectfully disagrees with the Examiner in regard to the § 101 rejection of claims 17-29 and 31-40, and submits that claims 17-29 and 31-40 are indeed directed to statutory subject matter. In particular, The USPTO has recently

published Interim Instructions for Evaluating Subject Matter Eligibility under 35 U.S.C. § 101 ("the Interim Instructions"), which set forth guidelines for determining if claims are directed to eligible patentable subject matter. The Interim Instructions provide a two part test for process claims - (i) the method claim must be implemented on a particular machine that imposes a meaningful limit on the claim's scope, and the use of the machine must involve more than insignificant extra-solution activity or (ii) the method claim must particularly transform a particular article to a different state or thing so as to impose a meaningful limit on the claim's scope, and the transformation must involve more than insignificant extra-solution activity. The Interim Instructions also indicate that "[f]or computer implemented processes, the 'machine' is often disclosed as a general purpose computer. In these cases, the general purpose computer may be sufficiently 'particular' when programmed to perform the process steps. Such programming creates a new machine because a general purpose computer, in effect, becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software." In addition the Interim Instructions further indicate that "tangible computer readable storage medium per se that possesses structural limitations under the broadest reasonable interpretation standard to qualify as a manufacture would be patent-eligible subject matter. Adding additional claim limitations to the medium, such as executable instructions or stored data, to such a statutory eligible claim would not render the medium non-statutory."

Claims 17-29, 31, 32, 38-40, and 42-48 recite, *inter alia*, "[a] computer-readable storage medium storing instructions for performing a method, when executed by a processor." Claims 33-37, 49, and 50 recite, *inter alia*, "a processing module

programmed to" perform various process steps." Thus, Applicant submits that claims 17-29, 31, 32, 38-40, and 42-48 are directed to an item of manufacture, while claims 33-37 are tied to a sufficiently particular machine in accordance with the Interim Instructions. Moreover, claims 33-37 recite, *inter alia*, "a processing module . . . programmed to determine a target payload . . . record payload weight data . . . determine a history of deviations . . . and modify the target payload." Accordingly, Applicant submits that the use of the "particular machine" in claims 33-37 involves more than insignificant extra-solution activity in accordance with the Interim Instructions.

For at least the above reasons, Applicant respectfully submits that claims 17-29 and 31-40 fall within the statutory categories of patentable subject matter. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 17-29 and 31-40 under 35 U.S.C. § 101.

§ 103(a) Rejection - Claims 1-6, 8-13, 16-22, 24-29, and 32-41

In order to establish a *prima facie* case of obviousness, the record must "include findings of fact concerning the state of the art and the teachings of the references . . . ." The Manual of Patent Examining Procedure ("M.P.E.P.") § 2141(II) (8th ed., rev. 6, July 2008) (relying on KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 82 U.S.P.Q.2d (BNA) 1385 (2007), and confirming the legal framework established by Graham v. John Deere Co., 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966)). Moreover, "[o]nce the findings of fact are articulated, [the rejection statement] must provide an explanation to support an obviousness rejection under 35 U.S.C. [§] 103." Id. If it is found that the prior art references fail to disclose all of the subject matter recited in a claim, the rejection

statement "must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III). The obviousness rejection set forth in the Office Action fails to consider each and every element of claims 1-6, 8-13, 16-22, 24-29, and 32-41, as explained below.

Claims 1-6, 8-13, 16, and 41 have been cancelled. For this reason, the § 103(a) rejection of these claims is rendered moot.

Regarding independent claim 17, Applicant submits that independent claim 17 includes certain features that are not disclosed, taught, or otherwise suggested by Helmly. In particular, independent claim 17 recites a computer-readable storage medium storing instructions for performing a method comprising, among other things, determining a target payload for one or more pieces of equipment during each of multiple different hauling events that should result in compliance with a payload standard over a calendar period of time; recording payload weight data during each individual hauling event; determining a history of deviations of the recorded payload weight data from the target payload; and modifying the target payload for future hauling events based on the history of deviations such that an actual loading profile of the one or more pieces of equipment for the calendar period of time substantially complies with the payload standard.

In the Office Action, the Examiner alleged that Helmly discloses the method of independent claim 17. In particular, the Examiner suggested that Helmly discloses determining a target payload and obtaining payload weight data. The Examiner then admitted that Helmly fails to disclose the step of modifying a target payload, but suggested that such a step would be obvious to prevent a payload from being above

legal limits. Applicant respectfully disagrees with the Examiner's allegations and suggestions.

In contrast to claim 1, Helmly is only concerned with measuring an actual payload during a single haul event, and ensuring that the measured payload is under a government-set legal limit. Helmly does not disclose or suggest a payload standard for a calendar period of time that spans multiple different hauling events, compliance with the payload standard, or a target payload during each of the multiple different hauling events that should result in compliance with the payload standard over the calendar period of time. In addition, regardless of whether Helmly discloses obtaining payload weight data, there is no mention in Helmly of recording of any data at all, much less recording payload weight data during each individual hauling event. Further, Helmly does not disclose or suggest determining a history of deviations of recorded payload weight data or, as the Examiner admitted, of modifying the target payload for future hauling events based on the history of deviations.

Further, regardless of whether it would be obvious to modify a payload, as suggested by the Examiner, it would not be obvious to modify a *target* payload, as required by independent claim 17. That is, one skilled in the art would recognize that the target payload is a goal value representative of, among other things, a payload that *should be* loaded into a particular haul machine. This definition is supported throughout the specification and the claims of the filed application. The target payload is not an *actual* amount loaded into a haul machine. In the Office Action, the Examiner pointed out a legal limit of Helmly as being a goal value. In particular, the Examiner indicated that, if a load is above the legal limit, a company would be in danger of legal action

taken against it. The Examiner then pointed out that the payload allegedly obvious to modify is the actual amount dispensed, such that the legal limit (i.e., the goal value) is not exceeded. Accordingly, the legal limit is the only goal value disclosed in Helmly that might be considered the target payload, and the legal limit is only regulated by the government. The legal limit is not a value obvious to modify, particularly not obvious to modify based on a history of deviations such that an actual loading profile for a calendar period of time substantially complies with a payload standard, as required by independent claim 17.

Because the rejection of independent claim 17 has failed to consider each and element of independent claim 17, the rejection of independent claim 17 is improper. Accordingly, Applicant requests the rejection of independent claim 17 be withdrawn.

Claims 18-29, and 32 ultimately depend from independent claim 17. For at least the reason of their dependency on independent claim 17, dependent claims 18-29, 31, and 32 should also now be allowed. Moreover, dependent claims 18-29, 31, and 32 present further features and are patentable for these additional features as well.

For example, claim 19 recites that the target payload is determined based on at least one of a slope of terrain or a type of terrain. In the rejection of claim 19, the Examiner alleged that Helmly discloses a target payload being based on a type of payload. Regardless of whether Helmly discloses a target payload being based on a type of payload, Helmly still fails to disclose or suggest a target payload being based on a slope or type of terrain, as required by claim 19. In fact, Helmly never mentions slope or type of terrain, as Helmly is only concerned with machine loading at a single location

and not of transportation of the loaded material across terrain. Claim 19 should be allowed for this additional reason.

Regarding independent claim 33, Applicant submits that independent claim 33 includes certain features that are not disclosed, taught, or otherwise suggested by Helmly. In particular, independent claim 33 recites, among other things, a processing module programmed to determine a target payload for one or more pieces of equipment during each of multiple different hauling events that should result in compliance with a payload standard over a calendar period of time, to record payload weight data during each individual hauling event, to determine a history of deviations of the recorded payload weight data, and to modify the target payload for future hauling events based on the history of deviations such that an actual loading profile for the calendar period of time substantially complies with the payload standard.

As recited above with respect to the rejection of independent claim 17, Helmly is only concerned with measuring an actual payload during a single haul event, and ensuring that the payload is under a government-set legal limit. Helmly does not disclose or suggest a payload standard for a calendar period of time that spans multiple different hauling events, compliance with the payload standard, or determining a target payload during each of the multiple different hauling events that should result in compliance with the payload standard over the calendar period of time. In addition, there is no mention in Helmly of recording of any data, of determining a history of deviations of recorded payload weight data, or of modifying the target payload for future hauling events based on the history of deviations.

Because the rejection of independent claim 33 has failed to consider each and element of independent claim 33, the rejection of independent claim 33 is improper. Accordingly, Applicant requests the rejection of independent claim 33 be withdrawn.

Claims 34-37 ultimately depend from independent claim 33. For at least the reason of their dependency on independent claim 33, dependent claims 34-37 should also now be allowed. Moreover, dependent claims 34-37 present further features and are patentable for these additional features as well.

Regarding independent claim 38, Applicant submits that independent claim 38 includes certain features that are not disclosed, taught, or otherwise suggested by Helmly. In particular, independent claim 38 recites, a computer-readable storage medium storing instructions for performing a method comprising, among other things, receiving a history of payload weight data, analyzing the payload weight data for compliance with a payload standard, and providing a modified target payload weight for a piece of equipment that differs from a historical target payload weight and that should ensure continued warranty coverage through a calendar time period of the payload standard.

In the Office Action, the Examiner admitted that Helmly fails to mention anything regarding warranty coverage or modification of a target payload weight. The Examiner then suggested it would be obvious to check for loading compliance, as overloading a vehicle could void a warranty. Applicant submits that, regardless of any obviousness to check for loading compliance, it is not obvious to provide a modified target payload weight, to provide a modified target payload weight that differs from a historical target payload weight, that the modified target payload weight is at all associated with a



warranty coverage, or that the modified target payload weight should ensure continued warranty coverage through a remainder of a calendar time period of a payload standard, as recited in independent claim 38. For these reasons, the rejection of claim 38 has failed to consider each and every element of independent claim 38. Accordingly, Applicant requests the rejection of independent claim 38 be withdrawn.

Claim 39 depends from independent claim 38. For at least the reason of its dependency on independent claim 38, dependent claim 39 should also now be allowed. Moreover, dependent claim 39 presents further features and is patentable for these additional features as well.

Regarding independent claim 40, Applicant submits that independent claim 40 includes certain features that are not disclosed, taught, or otherwise suggested by Helmly. In particular, independent claim 40 recites, a computer-readable storage medium storing instructions for performing a method comprising, among other things, obtaining payload weight data for each of multiple different hauling events; analyzing the payload data based on a payload standard and a first target payload; receiving as a result of the analysis, a second target payload different from the first target payload and that corresponds with compliance with the payload standard when achieved throughout a remainder of the multiple different hauling events; and modifying loading practices based on the second target payload.

As described above with respect to claims 17 and 33, Helmly is only concerned with measuring an actual payload during a single haul event, and ensuring that the payload is under a government-set legal limit. Helmly does not disclose or suggest a payload standard that spans multiple different hauling events, compliance with the

payload standard, or determining a second target payload that corresponds with compliance with the payload standard when achieved throughout a remainder of the multiple different hauling events. In addition, there is no mention in Helmly of modifying a loading practice based on the second target payload. For these reasons, the rejection of independent claim 40 has failed to consider each and every element of independent claim 40. Accordingly, Applicant requests the rejection of independent claim 40 be withdrawn.

Claim 41 has been cancelled. For this reason, the § 103(a) rejection of claim 41 is rendered moot.

§ 103(a) Rejection - Claims 7, 15, 23, and 31

Claims 7 and 15 have been cancelled. For this reason, the § 103(a) rejection of claims 7 and 15 is rendered moot.

Claims 23 and 31 depend from independent claim 17 and, as described above, Helmly fails to disclose or suggest a payload standard for a calendar period of time that spans multiple different hauling events, compliance with the payload standard, a target payload during each of the multiple different hauling events that should result in compliance with the payload standard over the calendar period of time, recording payload data, determining a history of deviations, or modifying a target payload. Schlessinger, which was cited only for an alleged teaching of a statistical analysis, fails to remedy the deficiencies of Helmly.

Because the rejection of claims 23 and 31 has failed to consider each and element of claims 23 and 31, the rejection of claims 23 and 31 is improper. Accordingly, Applicant requests the rejection of claims 23 and 31 be withdrawn.

New Claims 42-50

Applicant submits that new claims 42-48 are neither anticipated or rendered obvious by the prior art of record. In particular, claims 42-48 depend from one of independent claims 17 and 33 and are therefore allowable for the same reasons described above. In addition, claims 42-48 are allowable for their own recitations of novelty. For example, claims 42-48 recite, among other things, that the payload weight data includes a payload weight and a time duration; that the recorded payload weight data for at least one of the multiple hauling events is less than the target payload, and modifying the target payload includes increasing the target payload for future hauling events; that the payload standard is associated with a loading profile agreed-upon by a warrantor and a responsible party of the one or more pieces of equipment; and that a warranty is affected based on compliance with the agreed-upon loading profile. Applicant submits that none of these additional features are disclosed or suggested by the prior art of record.

Claims 49-50 recite a computer system for reviewing a request for warranty service, including, among other things, a processing module of the computer system programmed to analyze payload weight data for compliance with a payload standard; and based on the analysis, provide a modified target payload weight that differs from a historical target payload weight and that should ensure continued warranty coverage through a calendar time duration of the payload standard. Applicant submits that none of these features are disclosed or suggested by the prior art of record.

In view of the foregoing remarks, Applicant submits that the claims are neither anticipated nor rendered obvious in view of the prior art cited against this application.

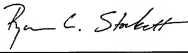
Applicant therefore respectfully requests the Examiner's reconsideration of the application, and the timely allowance of the pending claims. If upon receipt and consideration of this reply, Examiner Johnson is of the view that there are any other matters that require attention before this application can be allowed, or believes that a discussion with the undersigned representative would be of assistance in advancing the prosecution of this application to allowance, then he need only telephone the undersigned at **571-203-2742**, and the matter will be immediately addressed.

The Office Action contains characterizations of the claims and the related art, with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

By: 

Dated: December 2, 2009

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